UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
2457	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/929,995	TERNULLO ET AL.
	Examiner	Art Unit
	SARGON N. NANO	2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 February 2009</u>.

2a)☒ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1 , 3 - 20, 22- 24, 29 - 45, 47</u> is/are pending in the application.

   4a) Of the above claim(s) <u>2, 21, 25 - 28, 43, 44 and 46</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1, 3 - 20, 22- 24, 29 - 42,45 and 47</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is responsive to Pre – Brief Appeal Conference decision on

Feb. 10, 2009. Applicant's arguments with respect to the rejection(s) of claim(s) 1, 3 –

20, 22 – 24, 29 – 42, 45 and 47 have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a

new ground(s) of rejection is made. Consequently, claims 1, 3 – 20, 22 – 24, 29 – 42,

45 and 47 are pending examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

The term " substantially" in claim 1 is a relative term which renders the claim

indefinite. The term "sustantially" is not defined by the claim, the specification does not

provide a standard for ascertaining the requisite degree, and one of ordinary skill in the

art would not be reasonably apprised of the scope of the invention.

Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The claim recites the limitation a "standard format" which

renders the claim indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1, 3 – 20, 22 – 24, 29 – 42 and 45 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Lawlor et al. U. S. Patent No. 6,202,054 (referred to

hereafter as Lawlor) in view Shane et al U. S. Patent Pub. No. 2008/0223919 (referred

to hereafter as Shane).

As to claim 1, Lawlor teaches a method for utilizing an advertisement for a

service for accessing a service, the service being relevant to a location to a client device

at the location, said method comprising the steps of:

formatting, outside the client device, substantially all unsolicited advertising

information from the advertisement, the unsolicited advertising information

including (see col. 13, lines; Lawlor discloses an advertisement received by a

portable terminal screen of a user):

service information indicating the purpose of the advertisement (see col.15, lines

35 – 49, Lawlor discloses marketers such as retailers send advertisement indicating to a

consumer the significant benefits in value of a product);

data entry information indicating purchasing options based on the purpose (see.

col.31, lines 40 -55, Lawlor discloses bill of purchase paid through a user's account);

and

contact information containing instructions for enabling the client device to

communicate, with the service; forming an advertising signal containing the unsolicited

advertising information (see col. 30, lines 55 – col. 31, line 14; and col. 31, lines 40 -

55, Lawlor discloses a user responding to an advertisement as well as method of

purchasing) ;

propagating the advertising signal from a transmitter to the client device within

the location; receiving the advertising signal at the client device (see col. 39 , lines 5 -

32, Lawlor discloses an advertisement is sent to a remote terminal, this advertisement

being targeted to a specific user);

decoding the advertising signal to extract the unsolicited advertising information

(see col. 30, lines 55 – 67, Lawlor discloses and advertisement is responded to by a

user);

displaying the unsolicited advertising information to a user of the client device

(see col. 30, lines 55 - 67, Lawlor discloses an advertisement is displayed on a user's

portable device); and

determining, by the client device, a response to the advertising signal, based on the unsolicited advertising information (see col. 30 , lines 55 - 67, Lawlor discloses if an advertisement is responded to positively by a user and the user inquires more information, a sale information is sent to the user).

Lawlor teaches the invention as mentioned above. However Lawlor does not explicitly teach the use of XML elements. However, Shane teaches an automated machine which is operatively controlled by a consumer user station. The automated machine includes station at which a user can interact with the machine that is capable of outputting multiple forms of data such as visual, audio and text (such as XML) translated documents (see paragraphs 0060 and 0061).

It would have been obvious for one of the ordinary skill in the art at the time of the invention was made to modify Lawlor's invention by using the markup languages such as XML to allow incompatible systems to share data without the need to pass through multiple layers of conversion (see paragraph 0089).

As to claim, 3 Lawlor and Shane teach the method of claim 1 further comprising the steps of:

selecting the service based on the unsolicited advertising information and the response (see col. 30, lines 55 – col. 31, line 15);

communicatively coupling the client device with the selected service as a result of said step of selecting (see col. 30 line 55 – col. 31 line 15); and

communicating the selection and the response to the selected service (see col.5, lines 16 – 41 and col. 30, line 55 – col.31 line 15).

As to claim 4, Lawlor and Shane teach the method of claim 3 further comprising the step of constructing a user interface for allowing the user to communicate with the client device (see Lawlor col. 8, lines 27 - 37).

As to claim 5, Lawlor and Shane teach the method of claim 4 further comprising the step of receiving user inputs in response to the unsolicited advertising information (see Lawlor col.30, line 55 – col.31 line 14).

As to claim 6, Lawlor and Shane teach the method of claim 5 further comprising the step of formatting the user inputs, the response, and a portion of the unsolicited advertising information into a user reply, the user reply for making the user inputs available to the service (see Lawlor col.30, line 55 – col.31 line 14).

As to claim 7, Lawlor and Shane teach the method of claim 6 wherein the user reply is received at the transmitter (see Lawlor col.30, line 55 – col.31 line 14).

As to claim 8, Lawlor and Shane teach the method of claim 7 wherein the user reply is received as a wireless signal from the client device (see Shane paragraphs 0060 and 0061).

As to claim 9, Lawlor and Shane teach the method of claim 7 wherein the user reply is received at the transmitter using a communication interface providing electromechanical contact between the client device and the transmitter (see Lawlor col.30, line 55 – col.31 line 14).

As to claim 10, Lawlor and Shane teach the method of claim 9 further comprising the step of receiving a service response from the transmitter, the service response including, executable code for allowing the client device to interact with the service (see Lawlor col. 30, line 55 – col. 31, line 14).

As to claim 11, Lawlor and Shane teach the method of claim 6 wherein the user reply is sent directly from the client device received at a point-of-presence (POP) (see Lawlor col. 7, lines 1 - 21).

As to claim 12, Lawlor and Shane teach the method of claim 11 wherein the user reply is received over a personal digital assistant (PDA) interface providing electromechanical contact between the client device and the POP (see Shane paragraphs 0060 – 0061).

As to claim13, Lawlor and Shane teach the method of claim 12 further comprising the step of receiving a service response from the POP, the service response including executable code for allowing the client device to interact with the service (see Lawlor, col.7, lines 1 – 21).

As to claim 14, Lawlor and Shane teach the method of claim 1 wherein the advertisement is propagated as an optical signal through air (see Shane paragraphs 0060 - 0061).

As to claim 15, Lawlor and Shane teach the method of claim 14 wherein the optical signal has a wavelength in the range of 850 nanometers to 1250 nanometers (see Shane paragraphs 0060 - 0061).

As to claim16, Lawlor and Shane teach the method of claim 15 wherein the transmitter receives the advertisement over an Internet (see Lawlor col. 13 lines 27 - 32).

As to claim 17, Lawlor and Shane teach the method of claim 15 wherein the transmitter receives the advertisement over a fiber optic network (see Shane paragraphs 0060 and 0061).

As to claim 18, Lawlor and Shane teach the method of claim 1 wherein the client device is a personal digital assistant (PDA) (see Shane Paragraphs 0060 - 0061).

As to claim 19, Lawlor and Shane teach a method for conveying unsolicited information comprising the steps of:

preparing the unsolicited information by a service including: service information indicating the purpose of the information (see col. 13, lines 42 - 59);

data entry information indicating purchasing options based on the purpose (see col. 31 lines 40 – 50); and

contact information containing instructions for enabling the client device to

communicate with the service (see col. 30, line 55 – col. 31, line14);

receiving the unsolicited information from the service into a transmitter outside

the client device having a link layer (see col.30, lines 5 - 32);

formatting all the unsolicited information into a standard form in the transmitter

for transmission to a client device operating within a context associated with the

transmitter(see col. 13, lines 52 – 59); and

conveying the unsolicited information from the transmitter to the client device

over a communication medium (see col. 30, lines 55- 67).

As to claim 20, Lawlor and Shane teach the method of claim 19 wherein the

unsolicited information is comprised of an XML element. Lawlor does not explicitly teach

the use of XML elements. However, Shane teaches an automated machine with is

operatively controlled by a consumer user station. The automated machine includes a

station at which a user can interact with an interface that is capable of outputting

multiple forms of data such as visual, audio and text , such as XML translated

documents (see paragraphs 0060 and 0061).

It would have been obvious for one of the ordinary skill in the art at the time of

the invention was made to modify Lawlor's invention by using the markup languages

such as XML to allow incompatible systems to share data without the need to pass

through multiple layers of conversion (see paragraph 0089).

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As to claim 22, Lawlor and Shane teach the method of claim 19 wherein the

unsolicited information is conveyed from the transmitter as a diffuse infrared signal (see

Shane paragraphs 0060 - 0061).

As to claim 23, Lawlor and Shane teach the method of claim 22 wherein the

diffuse infrared signal has a wavelength in the range of substantially 850 nanometers to

1250 nanometers (see Shane paragraphs 0060 - 0061).

As to claim 24, Lawlor and Shane teach the method of claim 19 wherein the

client device includes a client device physical layer and a client device link layer

compatible with the link layer in the transmitter (see Shane paragraphs 0060 - 0061).

As to claim 29, Lawlor and Shane teach a method of utilizing executable code in

a transmitter for providing an advertisement to a client device, said method comprising

the steps of:

receiving the advertisement by the executable code in the transmitter from a

service provider about a service offered by the service provider (see col. 39, lines 5 -

32);

formatting the advertisement by the executable code in the transmitter for

transmission to the client device operating within a coverage area of the transmitter (see

col. 13, lines 52 – 59); and

conveying the advertisement by the executable code in the transmitter from the
transmitter to the client device over a communication medium (see col. 30, lines 55 –
67).

As to claim 30, Lawlor and Shane teach the method of claim 29 wherein the
advertisement is comprised an XML element. Lawlor teaches the invention as
mentioned above. However Lawlor does not explicitly teach the use of XML elements.
However, Shane teaches an automated machine with is operatively controlled by a
consumer user station. The automated machine includes a station at which a user can
interact with an interface that is capable of outputting multiple forms of data such as
visual, audio and text , such as XML translated documents (see paragraphs 0060 and
0061).

It would have been obvious for one of the ordinary skill in the art at the time of
the invention was made to modify Lawlor's invention by using the markup languages
such as XML to allow incompatible systems to share data without the need to pass
through multiple layers of conversion (see paragraph 0089).

As to claim 31, Lawlor and Shane teach the method of claim 30 wherein the
advertisement further comprises:

information enabling a user of the client device to make a decision about the service
provider, the decision being based on the service information (see col.30, line 55 – col.
31 line 14);

data entry information informing the user about utilizing a service offered by the service provider; and contact information containing instructions for enabling the client device to communicate with the service provider (see col. 31 lines 40 - 55).

As to claim 32, Lawlor and Shane teach the method of claim 29 wherein the advertisement is conveyed from the transmitter as a diffuse infrared signal (see Shane paragraph 0060 - 0061).

As to claim 33, Lawlor and Shane teach the method of claim 32 wherein the diffuse infrared signal has a wavelength in the range of   850 nanometers to 1250 nanometers (see Shane paragraphs 0060 - 0061).

As to claim 34, Lawlor and Shane teach the method of claim 33 wherein the diffuse infrared signal is generated by modulating an electric light (see Shane paragraphs 0060 - 0061).

As to claim 35, Lawlor and Shane a method of utilizing executable code in a client device receiving an unsolicited, formatted advertisement from a transmitter located outside the client device, said method comprising the steps of:

receiving the unsolicited, formatted advertisement from an infrared communication signal conveyed from the transmitter, wherein the transmitter formatted the advertisement, and arriving at a communication interface associated with the client

device, the unsolicited, formatted advertisement containing at least a portion of a

service offered by a service provider (see col. 13, lines 52 - 59);

decoding, the client device, the unsolicited, formatted advertisement to extract

information contained therein (see col. 30, lines 55 – 67);

relating, by the client device, the information to user-specific data in the client

device; and displaying, by the client device, the information related to the user-specific

data to a user of the client device (see col. 30, lines 55 – 67).

As to claim 36, Lawlor and Shane the method of claim 35 wherein said

unsolicited, formatted advertisement is comprised of an XML element. Lawlor teaches

the invention as mentioned above. However Lawlor does not explicitly teach the use of

XML elements. However, Shane teaches an automated machine with is operatively

controlled by a consumer user station. The automated machine includes a station at

which a user can interact with an interface that is capable of outputting multiple forms of

data such as visual, audio and text , such as XML translated documents (see

paragraphs 0060 and 0061).

It would have been obvious for one of the ordinary skill in the art at the time of

the invention was made to modify Lawlor's invention by using the markup languages

such as XML to allow incompatible systems to share data without the need to pass

through multiple layers of conversion (see paragraph 0089).

As to claim 37, Lawlor and Shane teach the method of claim 36 wherein the

unsolicited, formatted advertisement further comprises:

service information enabling the user to make a decision about the service, the

decision based on the service information (see col.15, lines 35 – 49);

data entry information informing the user about utilizing the service; and contact

information containing instructions enabling the client device to communicate with the

service provider (see. col.31, lines 40 -55).

As to claim 38, Lawlor and Shane teach the method of claim 37 wherein the

transmitter includes an emitter link layer (see Shane paragraphs 0060 - 0061).

As to claim 39, Lawlor and Shane teach the method of claim 38 wherein the

client includes a client device link layer (see Shane paragraphs 0060 - 0061).

As to claim 40, Lawlor and Shane teach the method of claim 39 wherein the

emitter link layer is compatible with the client device link layer (see Shane paragraphs

0060 - 0061).

As to claim 41, Lawlor and Shane teach the method of claim 40 wherein the

information about the service is displayed to the user if the client device is running a

plug-in cooperatively associated with the service (see col. 30, lines 55 - 67).

As to claim 42, Lawlor and Shane teach the method of claim 41 wherein the

plug-in further comprises information about a preference of the user (see col. 19, lines

54 - 62).

As to claim 45, Lawlor and Shane teach the method of claim 19 wherein the

unsolicited information is conveyed from the transmitter as a radio frequency (RF) signal

(see Shane paragraphs 0060 - 0061).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor

et al. U. S. Patent No. 6, 202, 054 (referred to hereafter as Lawlor) in view of Shane

Patent Pub. No. 2008/0223919 (referred to hereafter as Shane) and in further view of

Kahn at al U.S Patent No. 5, 844, 544 (referred to hereafter as Kahn).

As to claim 47, Lawlor and Shane teach a method for determining a user

response to predetermined information relevant to a client device at the location, said

method comprising the steps of:

formatting, outside the client device, the predetermined information including:

service information indicating the purpose of the service (see col.13, lines 52 –

59)

data entry information indicating options based on the purpose (see col. 31, lines

40 - 55); and

contact information enabling the client to communicate with the service (see col.

31, lines 44 - 55);

forming a signal containing the predetermined information (see col.13, lines 52 –

59);

propagating a signal containing from the transmitter to the client device within the

location (see col. 39 line 5 - 32);

receiving the signal at the client device (see col.39, lines 5 – 32),;

extracting the predetermined information; and determining, by the client device,

a user response to the predetermined information from user eye movement (see col.30,

lines 55 - 67).

Lawlor and Shane fail to explicitly teach the user response in the form of eye

movement, However Kahn teaches a visual communication apparatus where a user

makes a selection by eye movement. It would have been obvious to one of the ordinary

skill in the art at the time of the invention was made to incorporate the visual selection

feature in the above mentioned invention to provide visual communication for people

who can not or prefer not to use their hands to operate manual interface device (see

Kahn col. 1 lines 12 - 20).

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARGON N. NANO whose telephone number is (571)272-4007. The examiner can normally be reached on 8 hour.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sargon N Nano/
Examiner, Art Unit 2457

/ARIO ETIENNE/
Supervisory Patent Examiner, Art Unit 2457